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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Goddard et al. (as amended)
Appl. No. : 10/035,977
Filed : December 26, 2001
For : NUCLEIC ACIDS ENCODING
POLYPEPTIDES THAT INDUCE
CELL PROLIFERATION (as
amended)
Examiner : Kolker, Daniel E.
Group Art Unit : 1646

CERTIFICATE OF FAX TRANSMISSION

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July 1, 2005

(Date)


Marc T. Morley, Reg. No. 52,051SUPPLEMENTAL RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated March 10, 2005, Applicants filed an amendment and response on June 9, 2005. In that June 9th amendment and response, Applicants fully responded to the issues raised in the Office Action, and submitted the Declaration of Audrey Goddard, Paul J. Godowski, Austin L. Gurney, James Pan, Collin K. Watanabe and William I. Wood under 37 C.F.R. §1.131.

Applicants hereby submit and request consideration of a replacement Declaration of Audrey Goddard, Paul J. Godowski, Austin L. Gurney, James Pan, Collin K. Watanabe and William I. Wood under 37 C.F.R. §1.131. The replacement Declaration establishes that the presently claimed invention antedates the publication date of Ruben et al. (WO 99/58660). The Declaration of Goddard et al. establishes that the presently claimed subject matter was conceived of and reduced to practice prior to the publication date of Ruben, November 18, 1999. Thus, Applicants respectfully submit that the cited reference is not available as prior art, and request that the rejection under 35 USC §102(a) in view of Ruben et al. be withdrawn.

As set forth in 37 C.F.R. § 1.131, a patent applicant "may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective

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date of the reference or activity on which the rejection is based." *See also*, M.P.E.P. § 715. "The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of the invention in this country ... at least conception being at a date prior to the effective date of the reference." *See* M.P.E.P. § 715.07 (emphasis in original). The showing of facts must be sufficient to show "conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice." *See id.*

Ruben et al. was published on November 18, 1999. Ruben et al. is cited as a 102(a) reference because it allegedly discloses a nucleic acid sequence that is 95.3% identical to the sequence of SEQ ID NO: 56. However, as set forth below, Applicants were in possession of SEQ ID NO:56 prior to the publication date of Ruben et al.

The Declaration and attached Exhibit A demonstrate that the claimed subject matter, including a nucleic acid having the sequence of SEQ ID NO:56, was conceived by Applicants prior to November 18, 1999. Furthermore, as evidenced by the Declaration and Exhibit B, Applicants reduced the subject matter of the claims to practice from prior to the publication date of Ruben et al., by performing assays to confirm the function of the encoded polypeptide. Therefore, Applicants possessed as much of the claimed subject matter prior to the publication date of Ruben et al. Therefore, Ruben et al. does not anticipate.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §102 in view of Ruben et al.

CONCLUSION

In view of the above, Applicants respectfully maintain that claims are patentable and request that they be passed to issue. Applicants invite the Examiner to call the undersigned if any remaining issues may be resolved by telephone.